

REMARKS

Applicant has considered all points made by the Examiner in the Office Action and has responded to same in order to ensure compliance with the applicable rules.

1. Anticipation

Claims 1 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,203,753 issued to Rothhammer. ("Rothhammer"). Applicants respectfully traverse and submit that Claims 1 and 11, as amended, are patentable over Rothhammer.

Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue). When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant's claim 1 (as amended) contains additional grasping members not disclosed by Rothhammer. Applicant's claim 11 (as amended) contains a plurality of dumbbell shaped floatation members that are adapted to releasably engage each other; a feature not disclosed in by Rothhammer. Because these elements are recited in Applicant's claim 1 (as amended) and claim 11 (as amended), the Rothhammer reference cannot anticipate the present invention.

In light of the above, Applicant respectfully submits that claim 1 (as amended) and claim 11 (as amended) are not anticipated by the Rothhammer reference. Because claims 2-10 depend from claim 1 (as amended) and claims 12-16 depend from claim 11 (as amended) these claims are also not

anticipated by the Rothhammer reference. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 102(b).

2. 35 U.S.C § 103(a) Rejections – Rothhammer in view of Zarecky.

Claims 2, 4, 6, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rothhammer in view of U.S. Patent No. 5,464,379 issued to Zarecky (“Zarecky”). Claims 2, 4, 6, and 15 have been cancelled by Applicant.

3. 35 U.S.C § 103(a) Rejections – Rothhammer in view of Schook.

Claims 5-10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rothhammer in view of U.S. Patent No. 4,566,690 issued to Schook (“Schook”).

The Examiner has apparently used the Applicants’ claims as a blueprint to construct an obviousness rejection based on a number of unrelated references, which is impermissible. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It is improper to use hindsight having read the Applicants’ disclosure to “pick and choose” among isolated prior art references to disparage the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The fact that a prior art device could be modified to produce the claimed device is not a basis for obviousness unless the prior art suggest the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In this light, the reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that might point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). And finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990).

Applicants respectfully traverse this objection. According to the Manual of Patent Examining Procedure:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Manual of Patent Examining Procedure, § 2143.

The above rejection is improper because the cited references do not teach or suggest every limitation of the claimed invention. In order to make obvious Applicant's claimed invention, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), and there must be some suggestion or motivation to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1981). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Rothhammer discloses an "an upper body exercising device for use while standing or sitting in water." Schook discloses "weight training apparatus which includes an elongated handle and a plurality of separate weights mounted to each other and mounted to the handle." The Examiner proposes that one skilled in the arts would have been motivated to combine Rothhammer with Schook.

According to M.P.E.P. 2141.01(a), the P.T.O. field search classification is evidence of analogy. Because neither of the search field classifications of Schook is shared by the five search field classifications of Rothhammer, Applicant respectfully submits that in the judgment of prior Examiners there is insufficient analogy to find a motivation to combine. And the vast and varied interests associated with barbells means the fact that the word "barbell" appears in the Rothhammer and Schook patent titles is, without more, insufficient motivation to combine.

Assuming but not admitting some motivation to combine Rothhammer with Schook, the subject matter of Schook is not "reasonably pertinent to the particular problem with which the

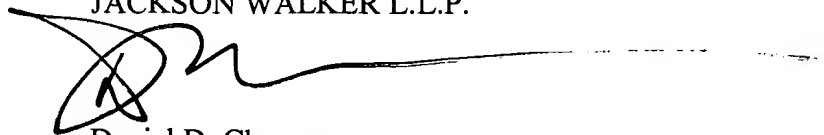
inventor is involved,” as is required for obviousness. *In re Clay*, 25 U.S.P.Q.2d 1059, 1060 (Fed. Cir. 1992). Weights made of steel are not pertinent or analogous to floatation devices. Schook teaches only the attachment of steel weights to the removed ends of a barbell to increase the weight of the barbell. Rothhammer teaches only the attachment of additional floatation elements to removed ends of a barbell floatation device to increase the buoyancy of the barbell. Neither Schook nor Rothhammer teaches the attachment of additional elements consisting of grasping members. The grasping members of Applicant’s invention provide a significant improvement over the prior art and should be recognized as more than an obvious extension of the cited references.

In addition, because no cited reference teaches or suggests the engagement of floatation elements end to end, each floatation element consisting of a grasping member, independent Claims 1 and 11 are not obvious in light of the cited references. If an independent claim is nonobvious under 35 U.S.C § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 5-10 ultimately depend from Claim 1. Claim 14 ultimately depends from Claim 11. Therefore, Applicant respectfully requests the Examiner to withdraw the obviousness rejection of Claims 5-10 and 14.

CONCLUSION

At this time and in view of Applicant’s amendments and arguments set forth above, it is respectfully submitted that all pending claims are allowable, and a Notice of Allowance is respectfully requested.

Respectfully submitted,
JACKSON WALKER L.L.P.

A handwritten signature in black ink, appearing to be 'D. Chapman', with a long horizontal line extending to the right.

Daniel D. Chapman
Reg. No. 32,726
112 E. Pecan Street, Suite 2100
San Antonio, Texas 78205
(210) 978-7700 (phone)
(210) 978-7790 (fax)
Attorneys for Applicant